

REMARKS

Claims 1-3 are all of the pending claims, with claims 1 and 3 being written in independent form.

I. Claim Rejection Under 35 USC §112(1st):

The Examiner rejects claims 1-3 under 35 USC §112(1st) because the term “at least four rotatably supported grinding disks” (recited in claims 1 and 3) is not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. This rejection position is not convincing for the following reasons.

The rejection is incorrect on its face. According to the Examiner, the objectionable term “allows there to be more than four disks,” but the specification does not disclose that there are more than four grinding disks. Applicant wholeheartedly agrees to the extent that the disclosed embodiment includes four grinding disks 1c1 – 1c4. Notwithstanding, the claim language reads squarely on the disclosed embodiment. In this regard, the Examiner seems to confuse breadth with enablement.

As set forth in the helpful examination guidelines of MPEP 2164, the test for enablement is whether the specification describes how to make and use the invention. The invention that must be enabled is that defined by the claims. As noted above, the objectionable term reads squarely on the disclosed embodiment. Accordingly, contrary to the Examiner’s assertions, Applicant respectfully submits that a skilled artisan could, in view of the specification, practice the invention defined by the claims.

In any event, and without acquiescing to the correctness of the Examiner’s rejection, Applicant amends independent claims 1 and 3 by altogether deleting the objectionable term. According to claims 1 and 3, the machine includes “a plurality of rotatably supported grinding disks.” Applicant points out that both claims (as amended) cover mobile machines having *four or more* grinding disks. In fact, the amended claims cover mobile machines having *two or more* grinding disks.

For at least these reasons, Applicant respectfully requests the Examiner to reconsider and withdraw the raised rejection under 35 USC §112(1st).

II. Claim Rejection Under 35 USC §112(2nd):

The Examiner rejects claims 1-3 under 35 USC §112(2nd) because the term “at least four rotatably supported grinding disks” (recited in claims 1 and 3) is indefinite. Applicant respectfully disagree for reasons analogous to those noted above. In any event, and without acquiescing to the correctness of the Examiner’s rejection, Applicant amends independent claims 1 and 3 by deleting the objectionable term. Applicant respectfully requests the Examiner to reconsider and withdraw the raised rejection under 35 USC §112(2nd).

III. Claim Rejection on Prior Art Grounds:

The Examiner rejects claims 1-3 under 35 USC §103 as being obvious over US 6,238,277 to Duncan et al. (“Duncan”) in view of US 4,513,469 to Godfrey et al. (“Godfrey”). Applicant respectfully traverses this rejection in view of the following remarks.

A. Independent Claim 1:

Independent claim 1 defines a mobile machine that includes (among other things) “two drive motors mechanically connected to the two wheels, respectively.” An example, non-limiting embodiment of this feature is depicted in Fig. 2. As shown, one motor 4a is connected to the wheel 4, and another motor 5a is connected to the wheel 5. At least the “two drive motors” feature (as recited in claim 1), in combination with the other features recited in claim 1, is not taught or suggested by the prior art relied upon by the Examiner.

The Examiner recognizes that Duncan is not pertinent to the claimed “two drive motors,” and therefore looks to the secondary reference of Godfrey to allegedly teach this feature. In so doing, the Examiner attempts to rely upon a modification of Duncan that involves implementing a pair of driven wheels (as taught by Godfrey). This rejection position is not convincing for the following reasons.

The Articulated Motivation is in Error.

According to the Examiner, the alleged modification would have been obvious “to allow an operator to remotely control [Duncan’s] device.” However, the Examiner has not pointed out why such a feature would have been desirable in the first place and/or any advantage that would be achieved by the alleged modification. Without this specific information, the Examiner’s position appears to be based upon an impermissible hindsight of the instant specification, and not the objective teachings of the references.

Furthermore, the primary reference to Duncan expressly indicates that an advantage of the disclosed floor grinder is that it may be manipulated “with ease and safety.” (col. 2, lines 52-54). In view of this teaching, those skilled in the art would have had no apparent reason to implement Godfrey’s remote control feature. With respect to the secondary reference to Godfrey, the disclosed remote control feature overcomes disadvantages associated with self-propelled randomly moving vacuum cleaners (e.g., changing directions is only caused by impact with walls and/or furniture). (col. 1, lines 16+). These disadvantages have nothing whatsoever to do with a manually controlled floor grinder (as disclosed by Duncan). Thus, those skilled in the art would have had no apparent reason to modify Duncan by implementing Godfrey’s remote control feature

Even if Combined, the Prior Art is Still Not Pertinent

For argument sake, even if those skilled in the art were somehow motivated to implemented the alleged modification, the resulting device would still not meet each and every feature of the invention defined by claim 1. Namely, and with reference to Fig. 2 of Godfrey, the drive rollers 22, 24 (which rotationally drive the wheels 18, 20) are mechanically connected to a *single motor 42*. This is simply not pertinent to the “two drive motors” defined by claim 1.

Applicant respectfully submits that Godfrey’s single motor feature is not incidental. Indeed, Godfrey expressly indicates that a “principal object” of the invention is to provide a *simple* remote radio control feature that utilizes a *simple mechanical structure* for providing steering and directional control. (col. 1, lines 30-43). In view of this straightforward disclosure, those skilled in the art would have been led directly away from any modification of Duncan that

involves implementing "two drive motors mechanically connected to the two wheels, respectively," as defined by claim 1. This is because two drive motors would necessarily make Godfrey's device more cumbersome and complicated.

B. Independent Claim 3:

Independent claim 3 is somewhat similar to claim 1 to the extent that claim 3 also recites a "two drive motors" feature. Accordingly, claim 3 is believed to be patentable for reasons analogous to those noted above with respect to claim 1.

IV. CONCLUSION:

In view of the above, Applicant earnestly solicits reconsideration and allowance of all of the pending claims.

Should there be any matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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By: _____



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